Supreme Court U.S.
FILED
DEC 23 2002
OFFICE OF THE CLERK

No. 02-633

In The
Supreme Court of the United States

MATTEL, INC.,

Petitioner,

v.

MCA RECORDS, INC., UNIVERSAL MUSIC INTERNATIONAL LTD., UNIVERSAL MUSIC A/S, MCA MUSIC SCANDINAVIA AB, AND UNIVERSAL MUSIC & VIDEO DISTRIBUTION, INC.,

Respondents.

On Petition For A Writ Of Certiorari To The United States Court Of Appeals For The Ninth Circuit

OPPOSITION TO PETITION FOR A WRIT OF CERTIORARI

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CORPORATE DISCLOSURE STATEMENT

Pursuant to Rule 29.6, respondents MCA Records, Inc., Universal Music International Ltd., Universal Music A/S, MCA Scandinavia AB, and Universal Music & Video Distribution, Inc., state that they are ultimately owned 92% by Vivendi Universal S.A., and 8% by Matsushita Electric Industrial Co., Ltd., both publicly held companies.

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PRELIMINARY STATEMENT

Mattel, Inc.'s ("Mattel") petition for a writ of *certiorari* should be denied because the Ninth Circuit's opinion is consistent with the approach of circuit courts that have considered trademark infringement claims where a trademark is used in an expressive work, or as the title of that work. In such cases, the Courts of Appeals recognize that the First Amendment adds an overriding constitutional dimension to an otherwise purely statutory determination. Only where the title has no artistic relevance to the underlying work and explicitly misleads as to the source or content of the work, or the work uses the trademark to comment on something unrelated to it, is it appropriate to treat the claim as any other trademark action. These exceptions were not present in this case, as both the Ninth Circuit and the District Court determined.

The Ninth Circuit's decision neither broke new ground nor deviated from precedent; rather, it adopted and followed the standard in the leading case on the issue, *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989). (*Rogers* implicitly had been the standard in the Ninth Circuit until its express adoption in this case.) The rationale of the Second and Ninth Circuit approach also is consistent with that in *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569 (1994), in which this Court affirmed strong First Amendment protection for parody (the expressive use at issue here) in the analogous area of copyright infringement.

Mattel further misapprehends the application of the Federal Trademark Dilution Act, 15 U.S.C. § 1125(c), and what constitutes commercial speech. It erroneously contends that the use of a trademark in an expressive work, and as a title of that work, stops being noncommercial

speech under 15 U.S.C. § 1125(c)(4)(B) once the work is sold to the public. What Mattel gets wrong is that the speech involved here – the song *Barbie Girl* and its title – is entirely expressive speech that does not propose a commercial transaction. Just because MCA sold its parody rather than giving it away in no way undermines that the song itself is noncommercial speech entitled to the full protection of the First Amendment.

Finally, Mattel rests its arguments on numerous factual misstatements that have no basis in the record. As to these points, the District Court either based its ruling on undisputed facts that were contrary to Mattel's current argument, or determined that Mattel had failed to present sufficient uncontroverted facts to enable the District Court to rule in Mattel's favor.

For all the foregoing reasons, respondents respectfully submit that the petition for a writ of *certiorari* should be denied.

REASONS TO DENY THE PETITION

I. The Ninth Circuit's Decision Is Consistent With The First Amendment And Other Circuits.

A. The Ninth Circuit Expressly Adopted *Rogers v. Grimaldi*.

The Ninth Circuit did not "abandon" what Mattel labels the "traditional likelihood-of-confusion test" for trademark infringement under the Lanham Act when it affirmed the District Court's grant of summary judgment in favor of respondents MCA Records, Inc., Universal Music International Ltd., Universal Music A/S, MCA Scandinavia

AB, and Universal Music & Video Distribution, Inc. (collectively "MCA"), dismissing Mattel's trademark claims concerning the popular song *Barbie Girl* which poked fun at Mattel's cultural icon the Barbie doll and its ubiquitous influence on society. It is *Mattel's* argument that advocates abandoning the traditional approach courts have applied in trademark cases that involve literary titles or parody.

Recognizing the First Amendment implications of its analysis, the Ninth Circuit expressly adopted the formulation in *Rogers v. Grimaldi, supra.* Pet. App. 8a. In *Rogers*, the Second Circuit held that the use of the title *Ginger and Fred* for a motion picture about fictional cabaret performers who imitated Ginger Rogers and Fred Astaire did not constitute trademark infringement despite survey evidence indicating that some members of the public could draw the incorrect inference that Rogers had some involvement with the film. *Rogers*, 875 F.2d at 1001. (The Court even assumed some people would be misled.) Nevertheless, the Court determined that the title was an integral element of the film and the film maker's artistic expression. *Id.* Therefore, the risk of consumer confusion "is so outweighed by the interests in artistic expression as to preclude application of the Lanham Act." *Id.*

Significantly, the Second Circuit in *Rogers* did not apply the likelihood of confusion factors of *Polaroid Corp. v. Polaroid Electronics Corp.*, 287 F.2d 492 (2d Cir. 1961), or state that analysis of those factors was necessary before it could affirm summary judgment. Instead, the Court engaged in an analysis of potential confusion that was tailored to the specific use at issue – a film title. The Second Circuit later applied *Rogers* to parody in *Cliffs Notes, Inc. v. Bantam Doubleday Dell Publishing Group, Inc.*, 886 F.2d 490 (2d Cir. 1989).

That is what the Ninth Circuit did here: it struck a balance between free expression and the trademark laws. Like the Second Circuit, the Ninth Circuit integrated the two inquiries into a synthesized standard that protects legitimate First Amendment rights as well as those of trademark holders. Based on the extensive (and undisputed) record before it, which included copies of the song, its lyrics, and its packaging,[1] the Ninth Circuit held that use of the term "Barbie" in the song title *Barbie Girl* clearly was relevant to the underlying work, which was a song parodying Barbie and the values the band Aqua saw that the Barbie doll represented. Pet. App. 8a. It further held that the song title *did not explicitly mislead as to the source of the work* and did not suggest, explicitly or otherwise, that the song was produced by Mattel. *Id.* This holding plainly contradicts Mattel's assertion here that the Ninth Circuit failed to consider the likelihood of confusion when it affirmed the grant of summary judgment. (The District Court *also* engaged in an analysis of the likelihood of confusion factors as stated in *AMF, Inc. v. Sleekcraft Boats*, 599 F.2d 341 (9th Cir. 1979), and found against Mattel. That determination was left undisturbed by the Ninth Circuit.[2])

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[1] The District Court had before it an extensive record on Mattel's unsuccessful motion for preliminary injunction (Pet. App. 21a-50a) and MCA's motion for summary judgment (Pet. App. 83a-118a).

[2] The Ninth Circuit acknowledged that the District Court had determined that MCA's use of the term Barbie was not likely to confuse consumers as to Mattel's affiliation with *Barbie Girl*. Pet. 2a. Additionally, the Court of Appeals noted that the likelihood of confusion test also governed Mattel's state law claims for unfair competition, and affirmed the District Court's grant of summary judgment against Mattel on those claims as well. Pet. App. 8a n.1.

The Ninth Circuit expressly adopted the approach of the Court in *Rogers*: "We agree with the Second Circuit's analysis and adopt the Rogers standard as our own." Pet. App. 8a. The Ninth Circuit took a similar tack ten years ago in a related context in *New Kids On The Block v. News America Publishing, Inc.*, 971 F.2d 302 (9th Cir. 1992), declining to apply the *Sleekcraft* factors where there was a non-trademark use of a mark (defendants had used a trademark to describe the plaintiff's product, rather than their own).[3] Similarly, courts that have addressed the issue of parody or use of literary titles in trademark infringement actions have followed approaches similar to that of *Rogers* and the opinion below. For example, in *Lyons Partnership v. Giannoulas*, 179 F.3d 384 (5th Cir. 1999), the Fifth Circuit recognized that the likelihood of confusion factors are unwieldy when the use of the mark is in a parody, that "parody should be treated differently from other uses that infringe on a trademark," and that an analysis of confusion must in all instances be conducted with reference to the parodic use of the mark. *Id.*, 179 F.3d at 390. *See also Anheuser-Busch, Inc. v. L. & L. Wings, Inc.*, 962 F.2d 316,

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[3] In that case, defendants used the trademark "New Kids On The Block" in newspaper opinion polls that asked readers questions about that well-known musical group. Recognizing that the mark at issue was being used in a non-trademark way – to refer to the band – the circuit court held that defendants' use was one to which the infringement laws did not apply. Consequently, such a use would not deceive the public and constituted a "nominative fair use." *New Kids*, 971 F.2d at 307-08. The District Court also granted summary judgment against Mattel based on the *New Kids* standard, an independent ground the Ninth Circuit did not reach. Pet. App. 8a.

321 (4th Cir. 1992) (parody of design of Budweiser beer label protected; the multi-factored inquiry "is at best awkward in the context of parody," which necessarily invokes the original trademark but also diminishes risk of consumer confusion); *L.L. Bean, Inc. v. Drake Publishers, Inc.*, 811 F.2d 26, 33 (1st Cir. 1987) (article in magazine parodying L.L. Bean's outdoor wear catalog protected speech; "application of the Maine anti-dilution statute to [defendant's] noncommercial parody cannot withstand constitutional scrutiny").

Moreover, numerous courts have recognized that, even in traditional trademark infringement actions, the likelihood of confusion factors simply are

> helpful *guidelines* to the district court. *These tests were not meant to be requirements* or hoops that a district court need jump through to make the determination. Our court has never articulated specific factors that a district court must recite and apply, instead, we have identified a *non-exclusive* series of factors that are *helpful* in making the ultimate factual determination.

Eclipse Associates Ltd. v. Data General Corp., 894 F.2d 1114, 1118 (9th Cir. 1990) (emphasis added). *See also, e.g., Lois Sportswear, U.S.A., Inc. v. Strauss & Co.*, 799 F.2d 867, 872 (2d Cir. 1986) (factors are designed to help in the ultimate determination of likelihood of confusion, not to be applied as a rigid formula); *A & H Sportswear, Inc. v. Victoria's Secret Stores, Inc.*, 237 F.3d 198, 214-215 (3d Cir. 2000) ("the factors are meant to be tools, not hurdles. . . . A district court should utilize the factors that seem appropriate to a given situation"); *L. & L. Wings*, 962 F.2d at 320 (factors not a "rigid formula" for infringement; "not all of the factors are of equal importance, nor are they always

relevant in any given case"); *Lyons Partnership,* 179 F.3d at 388 (factors "non-exclusive and non-dispositive"); *Wynn Oil Co. v. Thomas*, 839 F.2d 1183, 1186 (6th Cir. 1988) ("factors are simply a guide to help determine whether confusion would be likely to result.... They imply no mathematical precision"); *see also Han Beauty, Inc. v. Alberto-Culver Co.*, 236 F.3d 1333, 1338 (Fed. Cir. 2001) (TTAB need not discuss every factor; sufficient to focus analysis on dispositive factors).

In the face of this precedent, Mattel nevertheless argues to elevate to paramount significance (above even the First Amendment) a non-standard list of nonexclusive factors, the importance of which necessarily differs from case to case, that is used in various ways by courts in typical trademark infringement cases (those not involving First Amendment concerns). Mattel advocates the transformation of these fluid, merely "helpful guidelines" into what Mattel terms a "test" to be rigidly applied even in cases involving literary titles and parody, where use of the factors is awkward at best.

To advance this position, Mattel is forced to argue essentially that the Second Circuit somehow has retreated from its seminal opinion in *Rogers*. However, the cases on which Mattel relies simply reinforce what has long been recognized: expressive speech is different and must be treated differently in trademark infringement cases to ensure that First Amendment rights are not violated. For example, in *Cliffs Notes, supra,* the Second Circuit expressly recognized that the *Rogers* framework applies to parody. "We believe that the overall balancing approach of *Rogers* and its emphasis on construing the Lanham Act 'narrowly' when First Amendment values are involved are both relevant in this case." *Id.*, 886 F.2d at 494. The

Second Circuit also rejected the notion that rigid application of the *Polaroid* factors – the approach Mattel here advances – is appropriate: "The *Polaroid* test is at best awkward in the context of parody, which must evoke the original and constitutes artistic expression." *Id.*, 886 F.2d at 495 n.3. Accordingly, the Court reaffirmed that First Amendment considerations are primary in any confusion analysis, and on that basis reversed the finding of likelihood of confusion.

Similarly, in *Twin Peaks Productions, Inc. v. Publications International, Ltd.*, 996 F.2d 1366 (2d Cir. 1993), the Second Circuit reaffirmed that likelihood of confusion must be "particularly compelling to outweigh the First Amendment interest recognized in *Rogers*." *Id.*, 996 F.2d at 1379. The Court vacated a determination of trademark infringement because the District Court had not engaged in the balancing mandated by *Rogers* and had failed to determine whether evidence of confusion was so great that it could overcome the presumption of First Amendment protection. The other cases on which Mattel relies (Pet. 12) either did not involve parody, or were cases where the trademark was used to parody something unrelated to it – dispositively different contexts than here.[4] *See, e.g., Dr.*

[4] In the one exception, *Nike, Inc. v. Just Did It Enters.*, 6 F.3d 1225 (7th Cir 1993), the Court of Appeals reversed and remanded a district court's grant of summary judgment in favor of plaintiff on its claim that a parody of the Nike mark was confusing, admonishing the District Court that there was insufficient evidence that defendant's parody was confusing as a matter of law, and emphasizing that the primary consideration in the case was parody: "If the defendant employs a successful parody, the customer would not be confused, but amused." *Id.*, 6 F.3d at 1228.

Seuss Enters., L.P. v. Penguin Books, USA, Inc., 109 F.3d 1394 (9th Cir. 1997) (explaining difference between works that parody a trademark, which are Constitutionally protected, and using a trademark to create and sell a work about an entirely unrelated subject); *see also Campbell*, 510 U.S. at 580 (difference between using elements of copyrighted work to comment on original as opposed to instances where "the commentary has no critical bearing on the substance or style of the original composition").

B. Mattel's Focus On Marketing Was Considered By The Ninth Circuit And Does Not Change The Analysis.

Mattel embroiders its argument by also erroneously contending that the courts below failed to take into account the manner in which MCA purportedly marketed the *Barbie Girl* song. Contrary to Mattel's contention, the Ninth Circuit did not rule that marketing efforts are immune from liability "simply because they sought to promote an expressive work." Pet. 9. The primary evidence of marketing was MCA's reference to the title of the song – itself a permissible, protected use – in its promotion of the song. Given that MCA had the right to title its parody *Barbie Girl*, it certainly could (and must) use that title when promoting the song. Were this not so, the result would be illogical: a parodist could lampoon a subject, even refer to that subject in the title of the parody, but could not refer to the title of the work when attempting to sell it. It is hardly surprising, for example, that in *Rogers*, all the advertising and posters for the film used the title, as did press materials. *See Rogers v. Grimaldi*, 695 F. Supp. 112, 114 & n.2, 120 (S.D.N.Y. 1988). While it is true that Mattel *claimed* that the manner MCA promoted the song created

a likelihood of confusion, the District Court considered that contention and nevertheless held against Mattel based on the undisputed facts. *See § III infra.* (Mattel did not identify an issue relating to marketing efforts in its Statement of Issues on appeal.) That determination by the District Court was not disturbed by the Ninth Circuit.

II. The Ninth Circuit Correctly Interpreted The Dilution Act As Required By The First Amendment, And Consistently With Existing Law.

A. The Dilution Act May Not Regulate A Work Of Creative Expression, Which Is Not Commercial Speech.

As the Ninth Circuit recognized, the legislative history is express that the Dilution Act "will not prohibit or threaten noncommercial expression, such as parody, satire, editorial and other forms of expression that are not part of a commercial transaction." Pet. App. 13a. Mattel acknowledges that Congress neither "intend[ed] the [Dilution] Act to 'prohibit or threaten "noncommercial" expression, as that term has been defined by the courts,'" nor "to alter existing case law on the subject of what constitutes 'commercial' speech." Pet. 14, *citing* H.R. Rep. No. 104-374, at 4. Mattel's principal argument –that the Ninth Circuit "invented" a definition of "commercial speech" that it applied to the Dilution Act – misstates both the Ninth Circuit's opinion and the law.

The Court of Appeals repeated and applied the traditional definition of "commercial speech": speech that "does no more than propose a commercial transaction." Pet. App. 15a, *quoting Hoffman v. Capital Cities/ABC, Inc.*, 255 F.3d 1180, 1184 (9th Cir. 2001), *and Bolger v.*

Youngs Drug Prod's Corp., 463 U.S. 60, 66 (1983). "If speech is not 'purely commercial' – that is, if it does more than propose a commercial transaction – then it is entitled to full First Amendment protection." Pet. App. 15a, *citing Hoffman*, 255 F.3d at 1185-86. The Court recognized that any application of the Dilution Act to such noncommercial speech necessarily would "create a constitutional problem, because it would leave the FTDA with no First Amendment protection for dilutive speech other than comparative advertising and news reporting." Pet. App. 11a.

The definition of commercial speech applied by the Ninth Circuit is firmly established in this Court. *See Bolger*, 463 U.S. at 66 (the "core notion of commercial speech" is that it "does no more than propose a commercial transaction") (quotations omitted); *City of Cincinnati v. Discovery Network, Inc.*, 507 U.S. 410, 424 (1993) (defining "core commercial speech" as "speech which does no more than propose a commercial transaction"); *see also Virginia State Bd. of Pharmacy v. Virginia Citizens Consumer Council, Inc.*, 425 U.S. 748, 762 (1976). But even if there existed other definitions, this is not the case in which to explore that concept because the speech here would not be "commercial" under any reasonable definition: it consists of a parodic song that pokes fun at a cultural icon.

Mattel attempts to gloss over this dispositive fact by falling back on its meritless "marketing" argument, contending that it is the *marketing* of the *Barbie Girl* song that is commercial speech. But this formulation fares no better here than it does on Mattel's trademark infringement claim. If MCA is permitted to parody the Barbie doll and what it represents, then it necessarily can (in fact, must) refer to the title of its parody when it promotes the song. Under Mattel's construct, parody would lose

constitutional protection once the parodist tried to sell the parody. But selling copies of *Barbie Girl* does not transform the song or its title into commercial speech. *See Virginia State Bd. of Pharmacy,* 425 U.S. at 761 ("speech does not lose its First Amendment protection because money is spent to project it"); *Smith v. California*, 361 U.S. 147, 150 (1959) (for First Amendment purposes, "[i]t is of course no matter that the dissemination [of books] takes place under commercial auspices"); *Joseph Burstyn, Inc. v. Wilson*, 343 U.S. 495, 501-502 (1952) ("That books, newspapers, and magazines are published and sold for profit does not prevent them from being a form of expression whose liberty is safeguarded by the First Amendment"; applying rationale to motion pictures).

Nor is there any support for Mattel's contention that "hybrid" speech (even assuming that were the speech involved here) deserves lesser protection under the Dilution Act. To the contrary, where commercial and noncommercial speech are intertwined, the speech is accorded full First Amendment protection. *See Riley v. National Federation of the Blind of North Carolina, Inc.*, 487 U.S. 781, 796 (1988) ("we do not believe that the speech retains its commercial character when it is inextricably intertwined with otherwise fully protected speech. . . . Thus, where, as here, the component parts of a single speech are inextricably intertwined . . . we apply our test for fully protected expression").

The cases cited by Mattel do not change this analysis – they involved *commercial* speech that had not become an inextricably-intertwined "hybrid." *See Board of Trustees v. Fox*, 492 U.S. 469, 474-75 (1989) ("Tupperware parties" to sell housewares); *Anderson v. Treadwell*, 294 F.3d 453, 460 (2d Cir. 2002) (in-home solicitations by real estate agents).

Ultimately, however, this argument is irrelevant, given that MCA's song was purely noncommercial speech.

B. The Decision Does Not Conflict With Existing Law.

Mattel incorrectly contends that the Court of Appeals' decision conflicts with other cases interpreting state dilution statutes. One, *L.L. Bean,* 811 F.2d 26, *supra*, involved the *dismissal* of a dilution claim against a magazine that published a parody of plaintiff's product. That case is entirely consistent with this one – MCA merely sold the song embodying the parody, just as the defendant in *L.L. Bean* sold the magazine containing the parody.

Anheuser-Busch, Inc. v. Balducci, 28 F.3d 769 (8th Cir. 1994), another case cited by Mattel for this point, was a parody advertisement case involving a fake ad for "Michelob Oily." The *Balducci* Court distinguished *L.L. Bean* on its specific facts without rejecting its holding. The Court found infringement in addition to dilution, based on a factual record that the defendant displayed "very strong trademarks . . . virtually unaltered in the ad parody" and that

> no significant steps were taken to remind readers that they were viewing a parody and not an advertisement sponsored or approved by Anheuser-Busch. Balducci carefully designed the fictitious ad to appear as authentic as possible. Several of Anheuser-Busch's marks were used with little or no alteration. The disclaimer is virtually undetectable. Balducci even included a (R) symbol after the words Michelob Oily. These facts suggest that Balducci sought to do far more than just

> "conjure" up an image of Anheuser-Busch in the minds of its readers.

Id., 28 F.3d at 774. Given those starkly different facts, *Balducci* did not conflict with this case. The other cases that Mattel cites either did not involve a parody *of* a trademark, but rather use of a mark to "parody" something unrelated to it, *see Harley-Davidson, Inc. v. Grottanelli*, 164 F.3d 806 (2d Cir. 1999); *Mutual of Omaha Ins. Co. v. Novak*, 836 F.2d 397 (8th Cir. 1987); *Chemical Corp. of America v. Anheuser-Busch, Inc.*, 306 F.2d 433 (5th Cir. 1962), or, as Mattel admits, did not even involve an expressive use, *see Nabisco, Inc. v. PF Brands, Inc.*, 191 F.3d 208 (2d Cir. 1999).

III. The Petition Misstates And Omits Significant Facts.

Mattel incorrectly states, or fails to state, significant facts from the record. That it does so is understandable; the undisputed facts below defeat Mattel's contention that the marketing of *Barbie Girl* could or did confuse consumers. The more pertinent (but not the only) misstatements and omissions are set forth here.

There was no "Barbie music and music-related products," and consequently no market for such products. Pet. 2. None of Mattel's trademark registrations listed in its complaint applied to records, CDs, or cassettes. Additionally, several high-level Mattel employees admitted that they were unaware of any stand-alone CDs, audiocassettes or vinyl records of prerecorded music sold by Mattel at the time of the suit (other than music sold with a toy or as part of computer software or videos). Pet. App. 95a-96a. The few products on which Mattel focused were at most

"simply toys with accompanying music." Pet. App. 96a. Mattel failed to present any evidence that it currently was selling music, "except for a few products that are sold as toys in toy departments and are often accompanied by one of [Mattel's] dolls." Pet. App. 46a. In addition, Mattel did not provide any evidence that even these products were still being marketed at the time of the suit, and/or that consumers were aware of those products at the time. Pet. App. 96a. Mattel's products primarily were dolls, clothing, and assorted other similar products – not music or songs. Pet. App. 103a.

Mattel failed to present sufficient evidence of the core market for its toy products. In the District Court, Mattel refused to describe precisely its core target market for its toys, although some Mattel employees stated that purchasers were principally girls aged 3 to 11 (Pet. App. 45a, 104a), a range that Mattel repeats in its petition. Pet. 2. Even now, however, Mattel fails to provide clarity, continuing to assert different age ranges. Pet. 3. In the District Court, it went so far as to claim that its target audience was ages "zero to 100 plus." Pet. App. 104a. Ultimately, the District Court determined that the average buyer of *Barbie Girl* was a teenager, while Mattel's evidence variously claimed that its primary purchasers "were young children and adults – two groups distinct from teenagers" (Pet. App. 105a), rejecting Mattel's assertion that there was significant overlap between the market for its toys and the market for the *Barbie Girl* song.

There was no "Barbie pink." Pet. 3, 8. There was no evidence that MCA was marketing the *Barbie Girl* song either with "bright pink" or a pink similar to what Mattel claimed was "Barbie pink." Mattel also failed to show that its use of the color pink was protectible. Rather, the

undisputed facts were that the color pink is used on many products associated with young girls, and Mattel provided no evidence that its pink differed from that used on such other products. Pet. App. 33a, 39a n.18, 109a. Even Mattel's pending (but not yet accepted) application for trade dress registration was only for an image of the word Barbie with stylized, slanted, *white* lettering, apparently on a pink background, for dolls, doll clothing, and doll accessories only – not records, music, or CD products. Pet. App. 109a-110a. (Mattel abandoned its trade dress claim in its opposition to MCA's motion for summary judgment, although it unsuccessfully tried to resurrect it on appeal.)

MCA did not market the Barbie Girl song using similar motifs purportedly associated with Barbie toys. Pet. 4, 8. The marks used on MCA's products were not similar to Mattel's, and they employed different lettering, styles, and colors. For example, while the packaging of Mattel's toys generally included either an image of the Barbie or Ken doll, or revealed the actual doll, none of MCA's packaging had an image of any doll, resembling Barbie or not. Pet. App. 41a, 98a-99a. All of MCA's music CDs had a picture on their covers of the four band members, none of whom resembled Barbie or Ken. *Id.* MCA's CD album was mostly blue with a watery blue background, not pink, and utilized large rounded block lettering to identify the band name, "Aqua," and the album title, "Aquarium." The songs on the album, including *Barbie Girl*, were listed in small-size yellow lettering. Pet. App. 34a, 42a, 99a, 110a. The back of the album contained an asterisk denoting that the *Barbie Girl* song was "a social comment and was not created or approved by the makers of the doll," and also contained a notice that respondent MCA Records was the copyright holder. Pet. App. 42a.

None of the lettering was pink. In fact, pink did not appear anywhere on the front or back of the CD or cassette album case. Pet. App. 110a. In sum, according to the District Court: "This album is quite dissimilar from the style of packaging used on any of plaintiff's products." Pet. App 42a; *see also* Pet. App. 33a n.14.

Such differences were also present on the CD single version of the song, the packaging of which contained the name "Aqua" in big blue letters on the front cover, with use of light pink for some lettering, as well as a picture of the band. Pet. App. 34a, 42a, 110a-111a. The only other time that any shade of pink was used in MCA's packaging was with the CD-ROM version of *Barbie Girl*, where the title appeared in pink block lettering. Even in that instance, the letters were shadowed in dark pink outlined in both light and dark pink, together with rounded blue letters spelling the name "Aqua" with a white and blue outline. Pet. App. 110a-111a. The undisputed facts before the District Court (evidenced by copies of the album) were that this use of pink "differs significantly from the white-on-pink lettering that Mattel is attempting to claim as its trade dress. The curved, relatively thin lettering used by Mattel is quite distinct from pink block lettering used by Barbie Girl." Pet. App. 111a.

The promotional video used by MCA did not use props similar to "Barbie's Dream House." Pet. 4, 8. The *Barbie Girl* video bore little resemblance to the way Mattel packaged its products. According to the District Court, although the set of the video might invoke images of Barbie accessories, it was consistent with the band's attempt to parody the "Barbie fantasy world." Pet. App. 27a. The band members looked nothing like the dolls they spoofed; for example, the pretend Barbie character had a

tattoo and dark hair, and the pretend Ken character had a clean-shaven head, substantially different from Mattel's toys. Pet. App. 44a.

There were no "heart-shaped purses," only boxes, which were never used. MCA did not "produce[ ] a run of pink, heart-shaped purses." Pet. 4. As the record to which Mattel cites demonstrates, the items were boxes, not purses, and they were purchased by one respondent in England. ER 1199-1201. More significantly, Mattel did not present any evidence that consumers were even aware of the boxes, and for good reason – they never were intended to be, and never were, sold to consumers. Pet. App. 107a.

A handful of ambiguous e-mails was not indicative of confusion. Mattel claims that it received a few e-mails from young girls who allegedly thought Mattel was responsible for the *Barbie Girl* song. Pet. 4. However, the e-mails (an insignificant number in light of the thousands of e-mails that Mattel received) often either simply repeated the lyrics of the song, stated that the sender "loved" the song, or even explicitly recognized that the song was *not* approved by Mattel. The e-mails were ambiguous at best as to whether the writers believed Mattel was responsible for the song. Pet. App. 101a. According to the District Court, the evidence that Mattel presented on this point was "de minimis" and insufficient to demonstrate actual confusion. Pet. App. 101a; *see also* Pet. App. 44a.

The District Court properly gave little weight to Mattel's severely flawed survey, which did not indicate confusion in any event. Mattel erroneously claims that a survey it commissioned provided evidence of actual confusion. Pet. 4. The survey was severely flawed, entitling the District Court to give it little weight. *See Scott Paper Co. v. Scott's Liquid Gold, Inc.*, 589 F.2d 1225, 1231 (3d Cir.

1978). (Mattel also itself conducted a second survey which was so defective that Mattel does not even mention it in its petition. Pet. App. 72a.) Moreover, only *4 percent* of participants in the flawed survey indicated that they believed that Mattel or Barbie was the company that "puts out the [MCA] music video and CD (music CD)." Even when coupled with a second, misleading and improper question, only 17 percent answered that Mattel or Barbie was the company "connected with or [that] gave permission" for MCA's CD and video. Pet. App. 100a. The District Court was correct in not crediting this insufficient evidence of confusion.

Mattel's toys and MCA's song were not sold in the same retail channels. Contrary to Mattel's assertion that there were similar channels of distribution for Mattel's toys and MCA's song (Pet. 12), Mattel failed to show that *any* of its products were sold in the music sections of stores where MCA's CDs were sold. Pet. App. 101a. Mattel failed to present any evidence of even a *single instance* in which its toy products were sold among music CDs and cassettes at stores that sold both products. Pet. App. 102a. Nor did Mattel present evidence that any of its Barbie-related products were sold in music departments of stores, or that *Barbie Girl* was sold in stores except with other music. Pet. App. 40a-41a. The evidence was just the opposite. Pet. App. 40a-41a, 101a-102a. Additionally, the manner in which MCA's song and Mattel's toys were promoted was different. Pet. App. 103a.

There were no Barbie Girl "products." Pet. 8. There were no such things as "Barbie Girl products" marketed by MCA. In the words of the District Court, "the only product here is *one* song, *Barbie Girl*, which is sold in different forms and is performed by a new group that will be using totally different songs in future productions." Pet. App. 46a, 107a.

The facts below do not support the other points Mattel raises in its petition. The District Court made no determination as to whether, as Mattel now claims, MCA "attempted" to sell the *Barbie Girl* song at Toys 'R' Us, or that it "considered" advertising on Nickelodeon. Pet. 4, 8. Even were it true that MCA "attempted" or "considered" such (permissible) activities, *it was uncontroverted that MCA did not engage in them.* Nor did the District Court deem significant Mattel's assertion that NBC purportedly refused to air an advertisement for the song without a disclaimer. Again, even if true, this would be irrelevant to Mattel's claims.

CONCLUSION

Respondents put out a classic form of parody in a light-hearted pop song that poked fun at one of the most famous and ubiquitous "cultural icons" in the world. Not only does the First Amendment protect that expressive, noncommercial speech, but both the Ninth Circuit and District Court determined that the title of the song was not misleading and that consumers would not be confused. In so doing, both Courts followed established precedent. Respondents respectfully ask that the petition for a writ of *certiorari* be denied.

Respectfully submitted,

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December 23, 2002